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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,833	07/10/2001	Sarah Calvert	AA-09	9197
25917	7590	04/01/2005	EXAMINER	
LANGLOTZ PATENT WORKS, INC.			BOVEJA, NAMRATA	
PO BOX 759			ART UNIT	
GENOA, NV 89411			PAPER NUMBER	

3622

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/902,833

Applicant(s)

CALVERT ET AL

Examiner

Namrata Boveja

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-20 are presented for examination.

#### **Claim Rejections - 35 USC § 112**

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

2. Claims 14, 15, and 18 are rejected under 35 U.S.C. 112.

Claims 14 and 15 recite "at least a plurality of strategies" in lines 21 and 1 respectively. There is insufficient antecedent basis for this limitation in the claim, since "the plurality of strategies" was not cited in claims 13 or 11.

3. Claim 18 recites the limitation "based on the comparison" in line 7. There is insufficient antecedent basis for this limitation in the claim, since "the comparison" was not cited in claims 17 or 11.

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman et al.

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In reference to claims 1, 4, 5, and 18 Merriman discloses a method of serving Internet advertisements to users having associated cookies (col. 3 lines 45-46, and 52-57), assigning advertising strategies to each cookie (col. 5 lines 50-63), serving advertisements to the cookie based on the assigned strategy including a sequence of different advertisements (col. 6 lines 12-56). Although Merriman does not expressly state the establishment of at least two advertising strategies and comparing the strategies, it does disclose an untargeted advertising strategy (background) and a targeted strategy based on user characteristics (col. 9 lines 45-55). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify a random advertising strategy shown initially when user characteristics are unknown to a targeted strategy when user characteristics and reactions had been determined, because it is well known in the art that a targeted advertising strategy has a better response rate and is less likely to experience a decline in the response rate (col. 1 lines 45-63). Furthermore, it would have been obvious to adopt a targeted advertising strategy, since Merriman already anticipated that an untargeted strategy does not offer any advantage (background).

5. In reference to claims 2 and 16, Merriman discloses the presentation of a generic or promotional advertisement, which can be both random and untargeted, to a new user who has not previously been processed in the domain profile process (col. 5 lines 43-38).

6. In reference to claim 3 and 17, Merriman discloses the presentation of unrelated advertisements utilizing a formula to select different advertisements

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that match the user criteria (col. 6 lines 8-59). By tracking which advertisement has been presented for how long and by tracking data for the different advertisements, a decision is made as to which different advertisements should be presented to the user.

7. In reference to claims 6 and 19, Merriman discloses identifying users, assigning cookies to segments, and assigning a user identification and writing of a new cookie if the user browser is cookie enabled but no cookie is detected (Figure 2 and col. 5 lines 10-32).

8. In reference to claims 7 and 20, Merriman teaches the selection of Internet information characteristics from a group of characteristics (Figure 3A and col. 5 lines 50-63).

9. In reference to claim 8, Merriman does not expressly teach assigning an advertising strategy randomly. Official notice is taken that it is old and well known in the art of marketing to assign an advertising strategy randomly. For example, when advertising to a mass audience, a generic advertisement is utilized since information about the audience is limited. However, as information about the audience is collected and made available to the advertiser, more tailored and targeted advertisements are developed and presented to achieve better results.

Furthermore, an advertiser may show a sequence of advertisements to the target audience to determine the emotional appeal of a specific advertisement by tracking the impact on sales, the user click through rate, or another measure to determine which advertisement is most effective for

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that target audience.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to assign a random advertising strategy initially when not enough information is known about the target audience, and to modify the random advertising strategy at a later time to a targeted advertising strategy as more information about user characteristics is gathered to present the audience with more relevant and effective advertising.

10. In reference to claim 9, Merriman discloses the establishment of a second advertising strategy that is targeted based on user characteristics (col. 9 lines 45-55) and includes a sequence of advertisements selected on the basis of user characteristics and reaction to advertisements presented to the users (col. 6 lines 8-59).

11. In reference to claim 10 and 15, Merriman teaches the use of a generic or promotional advertisement on an initial website visit for a user with an undefined set of characteristics (col. 5 lines 42-49). Merriman also discloses the establishment of a second advertising strategy that is targeted based on user characteristics (col. 9 lines 45-55) and includes a sequence of advertisements selected on the basis of user characteristics and user reaction to presented (col. 6 lines 8-59). Both of these advertisement strategies utilize the same database (Figure 2) to locate advertisements that are presented to users, and therefore it is inherent that the two strategies include common advertisements.

12. With respect to claim 11, Merriman discloses a method of evaluating Internet advertisement effectiveness comprising: Collecting Internet activity

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information associated with a multitude of cookies (col. 3 lines 64 to col. 4 lines 11); storing the information in a database (col. 4 lines 43-51 and Figures 3, 3A, and 3B); generating an advertisement strategy for evaluation (col. 3 lines 53-57); establishing a plurality of user segments, each having a different Internet activity characteristic (Figure 3A and col. 5 lines 50-63); assigning an advertising strategy to each segment (col. 5 lines 50-63); determining a cookie for a user to whom an advertisement is to be served (col. 5 lines 18-33); retrieving the stored Internet activity information for the cookie (col. 5 lines 10-19 and 49-63); based on the retrieved information assigning the cookie to a user segment associated with the retrieved Internet activity information (col. 5 line 64 to col. 6 line 11); and serving an advertisement based on the assigned advertising strategy (col. 6 lines 12-67).

13. In reference to claim 12, Merriman teaches the generation of a different advertising strategy for at least some of the different segments. Merriman discloses the use of a generic or promotional advertisement for a new user who has not been previously processed in the domain profile process (col. 5 lines 44-50). Merriman discloses the use of a target profile criteria for users whose characteristic data is available and stored in the database (Figure 3B and col. 5 line 64 to col. 6 line 59). So, different advertising strategy is utilized for these two groups of users.

14. In reference to claim 13, Merriman discloses the selection of a sequence of different advertisements on the basis of user characteristics and reaction to advertisements presented to the users (col. 6 lines 8-59).

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15. In reference to claim 14, Merriman discloses the inclusion of a different sequence of advertisements (col. 6 lines 8-59).

**Conclusion**

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

- a) Judson Patent Number 5,737,619. Teaches downloading of hypertext documents when a user clicks on a hyperlink.
- b) Cezar et al. Patent Number 6,161,127. Teaches playing advertisements from a list and removing advertisements that have already been displayed.
- c) Oliver et al. Patent Number 6,845,374. Teaches development of a list of recommended documents based on certain criteria.
- d) Partovi et al. Patent Number 6,807,574. Teaches providing personalized content over the phone based on profiling information.
- e) Frangos "E-Commerce (A Special Report): Overview — How It Works: The technology behind Web ads." Wall Street Journal. April 23, 2001. Pg. R.12. Teaches how banner technology works to provide target marketing messages to users by using cookies.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 703-605-0725. The examiner can normally be reached on Mon-Fri, 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the



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examiner's supervisor, Eric Stamber can be reached on 703-605-0725. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

For the upcoming move to the new Alexandria office, everyone has been assigned new phone and Right Fax numbers. My new phone number will be: 571-272-8105, my supervisor's phone number will be: 571-272-6724. This change will not happen until April 2005 (or later) and therefore our current numbers are still in service until the move.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NB

March 2, 2005

*Yehdega Delta*  
*Primary Examiner*  
*AU 3622*